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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/524,272 | 03/13/2000 | Joseph A. Salowey | 2452-15 | 6713 |

23117 7590 01/12/2004
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EXAMINER

LIPMAN, JACOB

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2134

DATE MAILED: 01/12/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/524,272

Applicant(s)

SALOWEY, JOSEPH A.

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-7, 9-14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia, US Patent number 5,850,451, in view of Draper et al., US Patent number 5,924,096.

With regard to claim 1, 6, 7, 9, 10, 14, 16 and 17, Sudia discloses A method for establishing a secure connection between a client and a service, comprising; A client downloading and verifying a digitally signed instruction packet, executing the packet thereby controlling the client to store a new public key (column 39 lines 57-63), and using the stored key to establish a secure connection (column 39 line 63 – column 40 line 4). Saudi does not disclose the applet is run with a virtual machine such as the JAVA Virtual Machine, he only discloses the language used is firmware. Draper discloses that JAVA is a programming language that can be used instead of firmware (column 5 lines 1-2). It would have been obvious to one of ordinary skill in the art to write Sudia's instruction packet in JAVA to make it more portable.

With regard to claim 2 and 11, Sudia discloses the new public key would be stored in non-volatile memory (column 38 lines 46-49).

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With regard to claim 3 and 12, Sudia discloses the memory can comprise a disk (column 38 line 67 – column 39 line 1).

With regard to claim 4, 5, and 13, Sudia discloses the client would use the public key to verify subsequent signatures from the server (column 39 line 67 – column 40 line 2).

1. Claims 8, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sudia in view of Zerber, US Patent number 5,951,636.

With regard to claims 8, 15, and 18, Sudia teaches a client connecting with a server to download an applet to store a new public key, but does not mention a Java Archive. Zerber discloses a Java Archive being a standard way for servers to store applets (column 4 line 63 - column 5 line 4). It would have been obvious to one skilled in the art to have the server store and transmit Sudia's applets using a Java Archive, as taught by Zerber so as to store the files in compressed form.

Response to Arguments

2. Applicant's arguments filed December 9, 2003 have been fully considered but they are not persuasive.

3. Applicant suggested in response that Sudia's invention is a "device to execute firmware code that causes replacement of one public key with another" (page 10 paragraph 2). Then applicant then goes on to question whether the instructions are executable, after specifically stating that they are. In the previous paragraph, Applicant acknowledges that Sudia's replacement key is used "to replace or supplement keys", and is not only to replace one key with another.

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4. Applicant suggests that Firmware is embedded at manufacture, as apposed to being downloaded from the manufacturer (page 10 paragraph 3). Applicant paraphrases Sudia on the bottom of page 9 as disclosing, "a technique to replace or supplement keys embedded at time of manufacture". In this description it is unclear if the supplementing is accruing at time of manufacture, or if the original keys were embedded at time of manufacture. The actual disclosure, however, is very clear, "to replace or supplement 'instructions' public keys that were embedded during manufacture" (column 39 lines 43-45). It is clear from this that the supplementing happens after manufacture, as is also clear upon reading the entire disclosure.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 703-305-0716. The examiner can normally be reached on 7:30 - 5 M-Th, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JL


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100